REMARKS

The outstanding issues are as follows:

- Claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46 are rejected under 35 U.S.C. § 103(a); and
- Claims 4, 14-16, 22, 29, 37-39, and 43 are objected to as being allowable subject matter, but depending from non-allowable independent claims.

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the remarks contained herein. Claims 4, 14–16, 22, 29, 37–39, and 43 have been indicated as allowable by the Examiner if re-written in independent form. Therefore, claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46 remain pending in this application.

I. REJECTIONS UNDER 35 U.S.C. § 103(a)

As noted in Applicants' previous response, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the rejections do not satisfy these criteria.

A. No Motivation To Combine

The mere fact that references ***can*** be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either ***explicitly*** or ***implicitly*** in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

The Examiner admits that *Thornton* does not teach or suggest all of the claim limitations by itself, and offers *Laguer-Diaz* to supply many of the missing elements. The Examiner stated:

> Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Thornton el al. with the teaching of Laguer-Diaz et al. ... to reduce the amount of data transmitted to a monitoring and diagnostic service center (Column 5, Lines 19-25 & Column 8, Lines 39-42). Office Action, p. 3.

However, the Examiner fails to recognize that the teachings of *Thornton* and *Laguer-Diaz* do not teach or suggest the desirability of their combination, either explicitly or implicitly. In fact, *Thornton* explicitly teaches against the desirability of combining with the *Laguer-Diaz* invention.

In describing the Background of the Invention in *Thornton*, it states:

> The traditional approach to identifying locations with poor network RF coverage is to perform drive testing to determine wireless network RF coverage issues. Drive testing involves engineers driving in automobiles in wireless network coverage areas with radio equipment used for testing RF coverage. This process is expensive, slow, and very labor-intensive. Para. [0002].

Then, as *Thornton* summarizes its invention, it states, "The received information is a collection of the wireless device performance history and ***does not require costly, time-consuming drive testing or customer involvement***." Para. [0008] (emphasis added). *Laguer-Diaz* relates to transferring data from a vehicle collecting internal diagnostics. *Laguer-Diaz*, Title, Abstract. Thus, *Laguer-Diaz* relates to mobile testing which *Thornton* ***explicitly*** teaches is undesirable and is ***no longer required*** through implementation of its invention.

In determining the propriety of a proposed combination of references, it is necessary to determine whether or not the reference teachings would appear to be sufficient to one of ordinary skill in the art having the references before them to make the proposed combination. *In re Linter*, 458 F.2d 1013, 1016 (CCPA 1972); *see also* M.P.E.P. § 2143.01. When faced with one reference that teaches the undesirability of drive testing or testing from a moving

vehicle and which also teaches that its implementation will no longer require such methods, and a second reference that teaches methods for testing from a moving vehicle, one of ordinary skill in the art would not reasonably propose to combine the references. Here, the only possible motivation to support the Examiner's stated motivation comes improperly from the claimed invention. It is well-established that the teaching or suggestion to make the claimed combination ***must*** be found in the prior art, ***not*** in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The Examiner relies on their improper combination of *Thornton* with *Laguer-Diaz* to support each of his rejections of claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46. None of the other references cited to by the Examiner provide the same limitations as those relied on from *Laguer-Diaz*. Therefore, without *Laguer-Diaz*, the Examiner's rejections must fail. Applicants, thus, assert that each of claims 1-3, 5-7, 9, 10, 12, 17-20, 23-28, 30, 31, 33, 40-42, and 44-46 are patentable over the 35 U.S.C. § 103(a) rejection of record.

B. Does Not Teach or Suggest All Claim Limitations

Applicants believe that the improper combination of *Thornton* with *Laguer-Diaz* renders the Examiner's rejections moot. However, in addition to this improper combination, the proposed combinations would still not teach or suggest each of the claimed limitations as noted below.

1. Claims 1–3, 5–7, 9, 10, 12, 25–28, 30, 31, and 33

Claims 1–3, 5–7, 9, 10, 12, 25–28, 30, 31, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0176040 by Thornton et al., (hereinafter *Thornton*) in view of U.S. Patent No. 6,580,983 to Laguer-Diaz et al., (hereinafter *Laguer-Diaz*).

a. Claims 1–3, 5–7, 9, 10, and 12

Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." The Examiner cites to *Thornton* paragraphs [0037]

& [0038] as teaching this limitation. However, the selected portions from *Thornton* actually discuss determining which neighboring cell to hand-off too when hand-off is necessary. Para. [0038]. For example, paragraph [0037] discusses information regarding the algorithm and information used in scheduling for cell server transmissions and transmitted color code information. Para. [0037]. Paragraph [0038] discusses receiving a "received signal quality indicator" (RSQI) signal which is used, along with the color code information, by the mobile device 302 to determine ***the most appropriate neighbor cell server to use as a primary cell server when hand-off is necessary***. Para. [0038] (emphasis added). Neither paragraphs [0037] or [0038] teach or suggest receiving an indicator at the wireless device to begin taking measurement.

Although not cited to by the Examiner, *Thornton* also discloses an additional embodiment where a signal from the Quality Measurement Server (QMS) 103 is sent to the wireless device 302. Paras. [0043], [0045]. This signal received by the wireless device 302 also does not trigger the wireless device 302 to begin taking measurements, but instead prompts it to retrieve the desired information that has already been measured and stored in memory 310. Para. [0046]. The Examiner does not offer *Laguer-Diaz* for this limitation, nor does it teach or suggest this limitation. Therefore, the combination of *Thornton* and *Laguer-Diaz* fails to teach each and every limitation of claim 1. Applicants, thus, assert that claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2–3, 5–7, 9, 10, and 12 each depend directly or indirectly from independent claim 1 and, thus, inherit each of the limitations of clam 1. As such, claims 2–3, 5–7, 9, 10, and 12 are each patentable over the asserted combination of references. Applicants, thus, assert that claims 1–3, 5–7, 9, 10, and 12 are patentable over the § 103(a) rejection of record and respectfully request the Examiner to withdraw same.

b. Claims 25–28, 30, 31, and 33

Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement

Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz.* Therefore, the combination of *Thornton* and *Laguer-Diaz* fails to teach each and every limitation of claim 25 and, as such, Applicants respectfully request the Examiner to withdraw his rejection under 35 U.S.C. § 103(a).

Claims 26–28, 30, 31, and 33 each depend directly or indirectly from independent claim 25 and, thus, inherit each of the limitations of clam 25. As such, claims –28, 30, 31, and 33 are each patentable over the asserted combination of references. Applicants, thus, assert that claims 25–28, 30, 31, and 33 are patentable over the § 103(a) rejection of record and respectfully request the Examiner to withdraw same.

2. Claims 8 and 32

Claims 8 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 6,401,054 to Anderson, (hereinafter *Anderson*). Claim 8 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 8, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claim 32 depends from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal

from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants therefore assert that claim 32, through its dependence from independent claim 25, is patentable over the 35 U.S.C. § 103(a) of record.

3. Claims 11 and 34

Claims 11 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 5,805,200 to Counselman, III, (hereinafter *Counselman*). Claim 11 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Counselman.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Counselman* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 11, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claim 34 depends from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants

therefore assert that claim 34, through its dependence from independent claim 25, is patentable over the 35 U.S.C. § 103(a) of record.

4. Claims 13, 35, and 36

Claims 13, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Thornton* in view of *Laguer-Diaz* and in further view of U.S. Patent No. 5,987,306 to Nilsen, et al., (hereinafter *Nilsen*). Claim 13 depends from independent claim 1. Claim 1 requires, "receiving an indicator at said wireless probe to begin taking measurements of one or more variables." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Nilsen.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Nilsen* fails to teach each and every limitation of claim 1. Applicants therefore assert that claim 13, through its dependence from independent claim 1, is patentable over the 35 U.S.C. § 103(a) of record.

Claims 35 and 36 each depend from base claim 25. Claim 25 requires, "calculating statistical data at said wireless probe using said measured one or more variables, responsive to receiving a transition event notification." As noted above, *Thornton* teaches either a quality signal that is received and used to determine a neighboring cell server for hand-off, or receiving a signal from a Quality Measurement Server at a wireless device prompting the wireless device to retrieve data that has already been measured from the wireless device memory. Paras. [0037], [0038], [0043], [0045], and [0046]. *Thornton* does not teach or suggest, this limitation, nor does *Laguer-Diaz* and/or *Anderson.* Therefore, the combination of *Thornton, Laguer-Diaz,* and *Anderson* fails to teach each and every limitation of claim 25. Applicants therefore assert that claims 35 and 36, through their dependence from independent claim 25, are patentable over the 35 U.S.C. § 103(a) of record.

II. ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for indicating that claims 4, 14-16, 22, 29, 37-39, and 43 would be allowable if rewritten in independent form. However, Applicants believe that, based on the improper combination of *Laguer-Diaz*, the claims are currently allowable in present form.

III. CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10031298-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568265835US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

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